

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Markham et al.
Application No.: 09/913,970
Filed: March 28, 2002

Confirmation No. 8326
Group Art Unit: 1636
Examiner: David M. Sullivan

For: **LATENCY-ASSOCIATED REGULATORY REGION**
FROM HERPESVIRUS SAIMIRI HVS

December 20, 2006

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT UNDER 37 C.F.R. §1.312
PETITION TO CORRECT INVENTORSHIP
UNDER 37 C.F.R. § 1.48 AND 35 U.S.C. § 116

Sir:

Pursuant to discussions with Examiner Sullivan, Applicants provide the present Amendment in response to the Notice of Allowance dated October 2, 2006.

Pursuant to 37 C.F.R. § 1.48(a), please add **Kersten Hall**, citizen of Great Britain, of Institute of Cardiovascular Research, Level 11, Worsley Building, University of Leeds, Leeds LS2 9JT, Great Britain, and **David Meredith**, citizen of Great Britain, of Molecular Medicine Unit, Clinical Sciences Building, St. James's University Hospital, Leeds LS2 9JT, Great Britain, as inventors on the above-referenced application.

In accordance with 35 U.S.C. § 117, 37 C.F.R. § 1.42, and M.P.E.P. § 409.01(a)-(d), Aida Meredith, as the legal representative of deceased inventor David Meredith, has signed on behalf of deceased inventor David Meredith on all documents that require the signature of inventor David Meredith. A Power of Attorney is provided from Aida Meredith, in accordance with M.P.E.P. § 409.01.

In support of this petition, the following are included:

- (a) Statements pursuant to 37 C.F.R. § 1.48(a)(2) from Kersten Hall and Aida Meredith, stating that the error in inventorship occurred without deceptive intention;
- (b) A Supplemental Declaration and Power of Attorney executed by all joint inventors: Alexander Fred Markham, Adrian Whitehouse, and Kersten Hall, and Aida Meredith for deceased inventor David Meredith;

- (c) A Consent of Assignee document duly executed by Raymond Wolfson on behalf of the assignee of the above-identified application, the University of Leeds; and
- (d) Assignments to the University of Leeds executed by inventor Kersten Hall, to the University of Leeds, and by Aida Meredith, as the legal representative of deceased inventor David Meredith;
- (e) A copy of the recorded assignment of the above-identified application as documentary evidence of chain of title; and
- (f) Applicants hereby provide authorization to charge Deposit Account No. 50-0220 the petition fee in the amount of \$130.00, which is set forth in 37 C.F.R. § 1.17(i).

As noted above, a copy of the original recorded assignment of the above-identified application is included as documentary evidence of title, and the new assignments are concurrently being submitted for recordation pursuant to 37 C.F.R. § 3.11, in order to comply with the requirements of 37 C.F.R. § 3.73(b).

Kersten Hall and David Meredith were omitted as inventors as a result of error and without deceptive intention. Only after the application had been filed was it conclusively discovered that the unnamed inventors had been potentially omitted in error. Upon reviewing the claims as drafted and reviewing the facts, it was decided that Kersten Hall and David Meredith were joint inventors as to at least some of the claims, and thus, should be added to appropriately correct the inventorship under 35 U.S.C. § 116 and 37 C.F.R. § 1.48. A mistake of judgment concerning the proper inventive entity can constitute a correctable "error" within the meaning of 35 C.F.R. § 116. In re Schmidt, 130 U.S.P.Q. 404 (C.C.P.A. 1961). Further, the proper inventive entity need not be conclusively proved "so long as the existence of error without deceptive intention is satisfactorily demonstrated." In re Searles, 164 U.S.P.Q. 623, 628 (C.C.P.A. 1970).

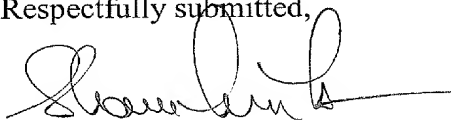
Therefore, it is respectfully requested that the omitted inventors be added to correct the inventorship on the above-mentioned application.

It is not believed that an extension of time and/or additional fee(s)-including fees for net addition of claims-are required, beyond those that may otherwise be provided for in documents accompanying this paper. In the event, however, that an extension of time is

In re: Markham et al.
Serial No. 09/913,970
Page 3 of 3

necessary to allow consideration of this paper, such an extension is hereby petitioned under 37 C.F.R. §1.136(a). The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 50-0220.

Respectfully submitted,



Shawna Cannon Lemon
Registration No. 53,888

USPTO Customer No. 20792

Myers Bigel Sibley & Sajovec, P.A.
P. O. Box 37428, Raleigh, NC 27627
Telephone: (919) 854-1400
Facsimile: (919) 854-1401

**CERTIFICATION OF TRANSMISSION
UNDER 37 CFR § 1.8**

I hereby certify that this correspondence is being transmitted electronically to the U.S. Patent and Trademark Office on Dec. 19, 2006 using the EFS:

Signature: Sarah Abraham Date: December 19, 2006
Typed Name of Person Signing Certificate: Sarah Abraham

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Markham et al.

Serial No. 09/913,970

Filed March 28, 2002

For: LATENCY-ASSOCIATED REGULATORY REGION
FROM HERPESVIRUS SAIMIRI HVS

Commissioner for Patents
Washington, DC 20231

**STATEMENT IN SUPPORT OF PETITION
FOR CORRECTION OF INVENTORSHIP UNDER 37 C.F.R. § 1.48(a)(2)**

I, **Kersten Thomas Hall**, do hereby declare and state as follows:

1. I was not originally named as an inventor on U.S. Patent Application Serial No. 09/913,970, but I should have been. This omission was inadvertent and occurred without any deceptive intention on my part.
2. The correct inventors on the above-identified patent application are Alexander Fred Markham, Adrian Whitehouse, Kersten Thomas Hall, and David Meredith.
3. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Kersten T. Hall
Kersten Thomas Hall

15th of December 2006
Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re. Markham et al.

Serial No. 09/913,970

Filed March 28, 2002

For: LATENCY-ASSOCIATED REGULATORY REGION
FROM HERPESVIRUS SAIMIRI HVS

Commissioner for Patents
Washington, DC 20231

**STATEMENT IN SUPPORT OF PETITION
FOR CORRECTION OF INVENTORSHIP UNDER 37 C.F.R. § 1.48(a)(2)**

I, **Aida Meredith**, do hereby declare and state as follows:

1. David Meredith was not originally named as an inventor on U.S. Patent Application Serial No. 09/913,970, but he should have been. This omission was inadvertent and occurred without any deceptive intention on his part.
2. The correct inventors on the above-identified patent application are Alexander Fred Markham, Adrian Whitehouse, Kersten Thomas Hall, and David Meredith.
3. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

A Meredith
Aida Meredith
Legal Representative of
deceased inventor David Meredith

15/12/06
Date

ASSIGNMENT

THIS ASSIGNMENT, made by us, **Kersten Hall**, citizen of Great Britain, Leeds LS2 9JT, Great Britain; and Aida Meredith, of 23 Redhouse Lane, Leeds LS 7 4RA, Great Britain, as the legal representative of deceased inventor **David Meredith**, citizen of Great Britain, Leeds LS2 9JT, Great Britain,

WITNESSETH: That,

WHEREAS, Kersten Hall and David Meredith are joint inventors of certain new and useful improvements in **LATENCY-ASSOCIATED REGULATORY REGION FROM HERPESVIRUS SAIMIRI (HVS)**, for which an application has been filed, or is being concurrently filed, in the United States Patent and Trademark Office. We hereby authorize and request Myers Bigel Sibley & Sajovec, P.A., to insert here in parentheses (Application No. 09/913,970) the application number of said application when known; and

WHEREAS, **The University of Leeds**, a Great Britain university having a principal place of business at Leeds LS2 9JT, Great Britain, hereinafter referred to as assignee, is desirous of acquiring the entire right, title, and interest in and to said invention as described in said application, and in and to any and all Letters Patent which shall be granted therefor in the United States of America and all foreign countries;

NOW, THEREFORE, To Whom It May Concern, be it known that for good and valuable consideration, the receipt and sufficiency of which is hereby acknowledged, we have sold and by these presents do hereby sell, assign, transfer, and convey unto the said assignee, its successors and assigns, the entire right, title, and interest in and to the said invention and application, and in and to any and all continuations, continuations-in-part, or divisions thereof, and in and to any and all Letters Patent of the United States of America and all foreign countries or reissues thereof which may be granted therefor or thereon, for the full end of the term for which said Letters Patent may be granted, together with the right to claim the priority of said application in all foreign countries in accordance with the International Convention, the same to be held and enjoyed by said assignee, its successors and assigns, as fully and entirely as the same would have been held and enjoyed by us if this assignment and sale had not been made.

We hereby request that said Letters Patent be issued in accordance with this assignment.

We further covenant and agree that, at the time of the execution and delivery of these presents, we possess full title to the invention and application above-mentioned, and that we have the unencumbered right and authority to make this assignment.

We further covenant and agree to bind our heirs, legal representatives, and assigns promptly to communicate to said assignee or its representatives any facts known to us relating to said invention, to testify in any interference or legal proceedings involving said invention, to execute any additional papers which may be requested to confirm the right of the assignee, its representatives, successors, or assigns to secure patent or similar protection for the said invention in all countries and to vest in the assignee complete title to the said invention and Letters Patent, without further compensation, but at the expense of said assignee, its successors, assigns, and other legal representatives.

IN WITNESS WHEREOF, I have hereunto set my hand and seal on this 15th day of December, 2006.

Kersten T. Hall (SEAL)
Kersten Thomas Hall

Witnessed by:

M. Jefferson

Date: 15th of DECEMBER 2006

IN WITNESS WHEREOF, I have hereunto set my hand and seal on this 15 day
of December, 2006.

Aida Meredith (SEAL)
Aida Meredith

Witnessed by:

Mark Cook

Date: 15th December 2006

DECLARATION AND POWER OF ATTORNEY FOR PATENT APPLICATION

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled LATENCY-ASSOCIATED REGULATORY REGION FROM HERPESVIRUS SAIMIRI (HVS),

the specification of which

☐ is attached hereto

OR

☒ was filed on February 18, 2000 as United States Application No. 09/913,970 or PCT International Application Number PCT/GB00/00537 and was amended on August 17, 2001; October 27, 2004; July 22, 2005; December 19, 2005; and July 28, 2006.

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment specifically referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 C.F.R. § 1.56, including for continuation-in-part applications, material information that became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

I hereby claim foreign priority benefits under 35 U.S.C. § 119(a)-(d) or (f), or § 365(b) of any foreign application(s) for patent, inventor's or plant breeder's rights certificate(s), or § 365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below any foreign application for patent, inventor's or plant breeder's rights certificate(s), or any PCT international application having a filing date before that of the application on which priority is claimed.

9903694.9	GB	02/19/1999	<input checked="" type="checkbox"/> Yes <input type="checkbox"/> No
Number	Country	MM/DD/YYYY Filed	Priority Claimed
			<input type="checkbox"/> Yes <input type="checkbox"/> No
Number	Country	MM/DD/YYYY Filed	Priority Claimed

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

POWER OF ATTORNEY: As a named inventor, I hereby appoint the following registered attorney(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith. I also appoint the following registered attorney(s) to represent me before all competent International Authorities in connection with any and all international applications filed by me with an appropriate receiving office claiming priority to the U.S. application. I also appoint the following registered attorney(s) to make or receive payment on my behalf in connection with the filing of such international applications.

Customer No. 20792
Myers Bigel Sibley & Sajovec, P.A.
P. O. Box 37428
Raleigh, North Carolina 27627
Telephone: (919) 854-1400
Facsimile: (919) 854-1401

Send correspondence to:

Customer No. 20792
Myers Bigel Sibley & Sajovec, P.A.
P. O. Box 37428
Raleigh, North Carolina 27627
Telephone: (919) 854-1400
Facsimile: (919) 854-1401

Direct telephone calls to:

Shawna Cannon Lemon
(919) 854-1400

Facsimile:

(919) 854-1401

POWER OF ATTORNEY: As a named inventor, I hereby appoint the following registered attorney(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith.

Customer Number:

20792

20792

PATENT TRADEMARK OFFICE

Send correspondence to:

Customer Number:

20792

20792

PATENT TRADEMARK OFFICE

Direct telephone calls to:

(919) 854-1400

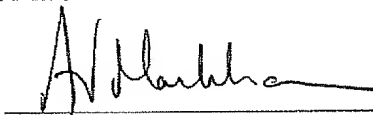
Facsimile:

(919) 854-1401

Full name of first inventor:

Alexander Fred Markham

Inventor's
Signature:



Date:

11th DECEMBER 2006

Residence:

Leeds, Great Britain

Citizenship:

Great Britain

Post Office Address:

Molecular Medicine Unit
Clinical Sciences Building
St. James's University Hospital
Leeds LS9 7TF, United Kingdom

Full name of second inventor: **Adrian Whitehouse**

Inventor's
Signature: A. Whitehouse Date: 18/12/06

Residence: Leeds, Great Britain

Citizenship: Great Britain

Post Office Address: Molecular Medicine Unit
Clinical Sciences Building
St. James's University Hospital
Leeds LS9 7TF, United Kingdom

Full name of third inventor: **Kersten Thomas Hall**

Inventor's

Signature: Kersten T. Hall Date: 15th of December 2006

Residence: Leeds, Great Britain

Citizenship: Great Britain

Post Office Address: 2 Wynford Rise
West Park
Leeds
LS16 6HX
GB

Full name of fourth inventor: **David Meredith**

Signature: *David Meredith* Date: 15/12/06

Executed by Aida Meredith, as legal representative of deceased inventor David Meredith

Residence: Leeds, Great Britain

Citizenship: Great Britain

Post Office Address: Molecular Medicine Unit
Clinical Sciences Building
St. James's University Hospital
Leeds LS9 7TF, United Kingdom

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Markham et al.

Serial No. 09/913,970

Filed March 28, 2002

For: LATENCY-ASSOCIATED REGULATORY REGION
FROM HERPESVIRUS SAIMIRI HVS

Commissioner for Patents
Washington, DC 20231

CONSENT OF ASSIGNEE

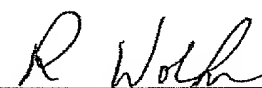
Sir:

The below-named officer who represents The University of Leeds, the assignee of the above-identified application, hereby consents to the amendment of the patent application under 37 C.F.R. § 1.48(a), to add the following joint inventors:

1. **Kersten Thomas Hall**, citizen of Great Britain, 2 Wynford Rise
West Park, Leeds, LS16 6HX, Great Britain
2. **David Meredith**, citizen of Great Britain, Leeds LS2 9JT, Great Britain

Respectfully submitted,

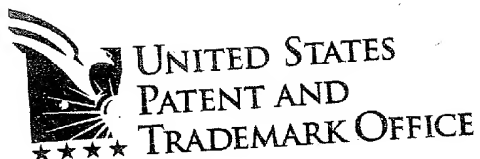
The University of Leeds

Signature: 

Name: Raymond Wolfson

Title: Director, Intellectual Property
Management Unit

Date: 18/12/06.



06-25-02A19:10 R0VD

9052-87

JUNE 18, 2002

PTAS

Chief Information Officer
Washington, DC 20231
www.uspto.gov

MYERS BIGEL SIBLEY & SAJOVEC
KAREN A. MAGRI
P.O. BOX 37428
RALEIGH, NC 27627



102065903A

UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 03/28/2002

REEL/FRAME: 012806/0893
NUMBER OF PAGES: 4

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:
MARKHAM, ALEXANDER FRED

DOC DATE: 02/25/2002

ASSIGNOR:
WHITEHOUSE, ADRIAN

DOC DATE: 03/14/2002

ASSIGNEE:
LEEDS, THE UNIVERSITY OF
LEEDS LS2 9JT, GREAT BRITAIN

SERIAL NUMBER: 09913970
PATENT NUMBER:

FILING DATE: 03/28/2002
ISSUE DATE:

SHARON BROOKS, EXAMINER
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

ASSIGNMENT RECORDATION FORM

tents Only

04-24-2002



102065903

March 22, 2002

Attorney Dkt. No. 5470.509

9052.87

To the Honorable Commissioner of Pa

Please record the attached original doc:

1. Name of conveying party(ies):

Alexander Fred Markham
Adrian Whitehouse



3.28.02

Additional name(s) of conveying party(ies) attached? Yes ☒ No

2. Name and address of receiving party(ies):

The University of Leeds
Leeds LS2 9JT
Great Britian

3. Nature of conveyance:

- ☒ Assignment
☐ Merger
☐ Security Agreement
☐ Change of Name
☐ Other _____

Execution Date: _____

Additional name(s) & address(es) attached? Yes ☒ No

4. Application Serial No. 09/913,970

Patent No.

If this document is being filed together with a new application, the execution date of the application is: _____

Additional numbers attached? Yes ☒ No

5. Name and address of party to whom correspondence concerning document should be mailed:

Karen A. Magri
Myers Bigel Sibley & Sajovec
P. O. Box 37428
Raleigh NC 27627

6. Total number of applications and patents involved: 1

7. Total fee (37 CFR 3.41) \$40.00

☒ Enclosed
☐ Authorized to be charged to deposit account

8. Deposit account number: 50-0220

DO NOT USE THIS SPACE

9. Statement and signature

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Karen A. Magri

Name of Person Signing

Signature

March 22, 2002

Date

Total number of pages including cover sheet, attachments and document: 4

04/02/2002 HML111 00000027 09213970

03 FC1581

40.00 DP

ASSIGNMENT

THIS ASSIGNMENT, made by us, **Alexander Fred Markham**, citizen of Great Britain, residing at Molecular Medicine Unit, Clinical Sciences Building, St. James's University Hospital, Leeds LS9 7TF, Great Britain; and **Adrian Whitehouse**, citizen of Great Britain, residing at Molecular Medicine Unit, Clinical Sciences Building, St. James's University Hospital, Leeds LS9 7TF, Great Britain;

WITNESSETH: That,

WHEREAS, we are the joint inventors of certain new and useful improvements in **LATENCY-ASSOCIATED REGULATORY REGION FROM HERPESVIRUS SAIMIRI (HVS)**, for which an application has been filed, or is being concurrently filed, in the United States Patent and Trademark Office. We hereby authorize and request Myers Bigel Sibley & Sajovec, P.A., to insert here in parentheses (Application No. 09/913,970) the application number of said application when known; and

WHEREAS, **The University of Leeds**, a Great Britain university having a principal place of business at Leeds LS2 9JT, Great Britain, hereinafter referred to as assignee, is desirous of acquiring the entire right, title, and interest in and to said invention as described in said application, and in and to any and all Letters Patent which shall be granted therefor in the United States of America and all foreign countries;

NOW, THEREFORE, To Whom It May Concern, be it known that for good and valuable consideration, the receipt and sufficiency of which is hereby acknowledged, we have sold and by these presents do hereby sell, assign, transfer, and convey unto the said assignee, its successors and assigns, the entire right, title, and interest in and to the said invention and application, and in and to any and all continuations, continuations-in-part, or divisions thereof, and in and to any and all Letters Patent of the United States of America and all foreign countries or reissues thereof which may be granted therefor or thereon, for the full end of the term for which said Letters Patent may be granted, together with the right to claim the priority of said application in all foreign countries in accordance with the International Convention, the same to be held and enjoyed by said assignee, its successors and assigns, as fully and entirely as the same would have been held and enjoyed by me if this assignment and sale had not been made.

enjoyed by said assignee, its successors and assigns, as fully and entirely as the same would have been held and enjoyed by me if this assignment and sale had not been made.

We hereby request that said Letters Patent be issued in accordance with this assignment.

We further covenant and agree that, at the time of the execution and delivery of these presents, we possess full title to the invention and application above-mentioned, and that we have the unencumbered right and authority to make this assignment.

We further covenant and agree to bind our heirs, legal representatives, and assigns promptly to communicate to said assignee or its representatives any facts known to us relating to said invention, to testify in any interference or legal proceedings involving said invention, to execute any additional papers which may be requested to confirm the right of the assignee, its representatives, successors, or assigns to secure patent or similar protection for the said invention in all countries and to vest in the assignee complete title to the said invention and Letters Patent, without further compensation, but at the expense of said assignee, its successors, assigns, and other legal representatives.

IN WITNESS WHEREOF, I have hereunto set my hand and seal on this 25th day of February, 2002

A. Fred Markham (SEAL)
Alexander Fred Markham

Witnessed by:

S. J. Shaw

Date: 20th February 2002

IN WITNESS WHEREOF, I have hereunto set my hand and seal on this 14th day of March, 2001.

A. Whitehouse (SEAL)
Adrian Whitehouse

Witnessed by:

S. J. Shaw

Date: 14-3-02